

REMARKS

Applicants appreciate the Examiner's thorough consideration provided in the present application. Claims 1, 2 and 5-22 are currently pending in the instant application. Claims 1 and 2 have been amended. Claims 1 and 15 are independent. Claims 6-22 have been added for the Examiner's consideration. Applicants submit that the subject matter of additional claims 6-22 is fully supported by the original written description; including, but not limited to, original claims 1-5, Tables 1-3 and pages 5-9 of the present application. Reconsideration of the present application is earnestly solicited.

Priority

Applicants appreciate the Examiner's indication of acceptance of the certified copy of the corresponding priority documents for the present application.

Claim Objections

Applicants appreciate the Examiner's identification of potential minor informalities with the claims of the present application. In light of the foregoing amendments to claim 1, Applicants submit that this objection has

been obviated and/or rendered moot. However, Applicants submit that this non-narrowing amendment has not been made responsive to any statutory rejection advanced by the Examiner.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodman et al. (U.S. Patent No. 4,998,543) in view of Official Notice. This rejection is respectfully traversed.

In light of the foregoing amendments to the claims, Applicants respectfully submit that all of the rejections have been obviated and/or rendered moot. Without conceding the propriety of the Examiner's rejection, but merely to expedite the prosecution of the present application, Applicants have amended claims 1 and 2 to clarify the claimed invention for the benefit of the Examiner. Accordingly, this rejection has been obviated and/or rendered moot.

With respect to claim 1, Applicants submit that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention, including the feature(s) of: "an outside wrapper paper sheet wrapping an outer circumferential surface of the inside

wrapper paper sheet, wherein the inside wrapper paper sheet has a *heat conductivity of $0.5 \text{ W} \cdot \text{K}^{-1} \cdot \text{m}^{-1}$ or more and the outside wrapper paper sheet has a heat conductivity of less than $0.5 \text{ W} \cdot \text{K}^{-1} \cdot \text{m}^{-1}$, and the inside wrapper paper sheet contains 0 to 0.5% by weight of a loading material.*" (Emphasis Added) Accordingly, this rejection should be withdrawn.

Applicants submit that the references of the prior art of record relied upon by the Examiner do not teach or suggest the above-identified features of the claimed invention. With respect to claim 1 and additional claim 15, Applicants submit that Goodman et al. clearly does not teach or suggest the feature of the inside wrapper paper sheet containing 0 to 0.5% by weight of a loading material.

Goodman et al. describes wrapping a tobacco rod in a double layer of paper. The inner wrapper contains about 2-15% by weight of a calcium carbonate loading (see col. 1, lines 51-52 and col. 3, lines 13-15 of Goodman et al.). However, Goodman et al. does not teach or suggest increasing or decreasing the amount of calcium carbonate beyond the range specifically described, e.g., "about 2-15% by weight." At col. 3, lines 15-19, Goodman et al. states that this "relatively low calcium carbonate loading helps to slow down the burn rate of the inner paper." However, the relatively low calcium

carbonate loading specifically relates to "2-15% by weight of calcium carbonate" and cannot reasonably be interpreted and/or extrapolated to correspond to the claimed range of 0 to 0.5% by weight of a loading material of the claimed invention.

The Examiner's suggestion that Applicants have indicated that Goodman et al. inherently teaches the claimed invention of claim 1 is traversed and/or improper. Applicants have not given any indication that the prior art of record teaches or suggests the unique range of the claimed invention. As described in reference to the background art, Applicants clearly indicate that none of the references "discloses or even suggest that the heat conductivity of wrapper paper is correlated to the fire spreading property of cigarette." (see page 3, lines 23-26 of the present application). Therefore, the Examiner's suggestion that this correlation has somehow been suggested by Applicants as being known in the background art is traversed, e.g., the Examiner states that "Applicant has, at least, inferred, in the instant specification, that low calcium carbonate loading and burn additive amounts will increase heat conductivity, and high calcium carbonate loading and burn additives will lower same." (See Office Action, page 3) The Examiner is not permitted to rely upon Applicants own teachings to modify the prior art of record. Further, the Examiner's suggestion

that routine experimentation would have lead one of ordinary skill in the art to Applicants' claimed invention is traversed. Applicants have identified a problem that is not art-recognized and a solution that heretofore has only been identified by Applicants, e.g., the Examiner has not provided any basis in the prior art of record to support this rejection, and/or Applicants solution to this problem. Accordingly, Applicants request that the Examiner provide actual evidence in the prior art of record to support the Examiner's opinions as to the modification.

In addition, Goodman et al. does not teach or suggest a heat conductivity of $0.5 \text{ W} \cdot \text{K}^{-1} \cdot \text{m}^{-1}$ or more, e.g., this limitation is not inherent in Goodman et al. as suggested by the Examiner. Accordingly, this rejection should be withdrawn and the present application should be passed to Issue.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicants respectfully submit that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application. Accordingly, reconsideration and withdrawal of the claim rejection are respectfully requested. Applicants respectfully request that the present application is currently placed in condition for allowance.

As to the dependent claims, Applicants respectfully submit that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

In accordance with the above amendments and remarks, Applicants respectfully submit that the claims of the instant application define over the prior art of record. Accordingly, reconsideration and withdrawal of the claim rejections are respectfully requested.

CONCLUSION

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of-the-art, no further comments are deemed necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

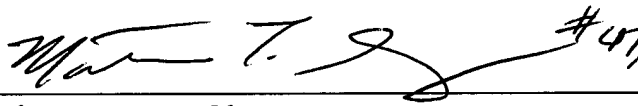
In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of **\$110.00** is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #47,074
James M. Slattery
Reg. No. 28,380

JMS/MTS/cl

P. O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000